

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. APPLN. NO. 10/051,070
ATTORNEY DOCKET NO. Q68238

REMARKS

Applicants request that the Examiner acknowledge Applicants' claim to foreign priority, and to indicate that the certified copy of the priority document, Japanese Patent Application No. Heisei 9-149403 dated June 6, 1997 has been made of record in the file.

Claims 1-6 and 8-25 have been examined on their merits. Claim 7 was previously cancelled in the Preliminary Amendment filed April 23, 2002.

Applicants herein cancel claims 4, 13 and 21 without prejudice and/or disclaimer.

Applicants herein amend claims 5, 6 and 14-16 to correct dependency and to correct grammatical errors. No new issues requiring further search and/or consideration by the Examiner are presented. Entry and consideration of the amendments to claims 5, 6 and 14-16 is respectfully requested.

Applicants herein amend claims 1, 9, 10, 18-20 and 22-25 to recite that the volume-based amount of lubricating oil in the sealed bearing space does not include any lubricating oil preliminarily contained in a rolling element cage. In the July 11, 2003 Rule 111 Amendment, Applicants had discussed this feature of the invention, although it was not claimed at that time. *See, e.g.*, pages 14 and 15 of the July 11, 2003 Amendment. At that time, Applicants had pointed out to the Examiner that lubricating oil injected into the sealed bearing space is different from lubricating oil impregnated in a rolling element cage. *See id.* In order to advance the prosecution of this application, Applicants are now amending claims 1, 9, 10, 18-20 and 22-25 to overcome the Examiner's continued reliance on Uchiyama *et al.* as allegedly disclosing the volume-based amount of lubricating oil in the sealed bearing space. No new issues requiring

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further search and/or consideration by the Examiner are presented. Entry and consideration of the amendments to claims 1, 9, 10, 18-20 and 22-25 is respectfully requested.

Claims 1-3, 5, 6, 8-12, 14-20 and 22-25 are all the claims presently pending in the application.

1. Claims 1-9 and 18-23 stand rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Uchiyama *et al.* (U.S. Patent No. 5,575,570). The rejection of claims 4, 7 and 21 is now moot due to their cancellation. Applicants traverse the rejection of claims 1-3, 5, 6, 8, 9, 18-20, 22 and 23 at least for the reasons set forth below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

As discussed in the July 11, 2003 Rule 111 Amendment, Uchiyama *et al.* disclose, *inter alia*, a rolling element cage is molded from a resin material, and immersed in lubricating oil to

impregnate the lubricating oil into the resin cage. *See* col. 5, lines 36-40; col. 6, lines 20-30 of Uchiyama *et al.* Preferably, the rolling element cage has an oil content of 0.2% to 15% by weight, wherein oil content means the percentage of the weight of the impregnated oil based on the dry weight of the rolling element cage prior to the oil infiltration. *See* col. 5, lines 61-66 of Uchiyama *et al.*

Uchiyama *et al.* fail to teach or suggest a bearing with an amount of lubricating oil injected into a bearing space defined between bearing space sealing members, wherein the amount of injected lubricating oil is: (1) in a range of 1 to 50% by volume of the bearing space, and (2) excludes any lubricating oil preliminarily impregnated in a rolling element cage. The language of claim 1 specifies that the amount of lubricating oil injected into the bearing space is based upon the volume of the bearing space defined by the sealing members. In contrast, Uchiyama *et al.* disclose that the amount of lubricating oil used in a rolling bearing is the amount of oil (by weight) impregnated into the rolling element cage. While the Examiner argues that the cage oil weights of Uchiyama are considered to generate volume percentages that overlap those recited in claim 1, in fact the language of claim 1 specifically *excludes* any lubricating oil that is impregnated in the rolling element cage from the volume-based amount of lubricating oil injected into the bearing space. As is plainly stated in the instant specification, the lubricating oil injected into the bearing space is different than the lubricating oil impregnated in a rolling element cage. *See* page 9, lines 8-12 of the instant specification. Moreover, nowhere has the Examiner illustrated how one of ordinary skill in the art would allegedly derive the volume percentages recited in claim 1 based on the oil weight percentages disclosed in Uchiyama *et al.*,

especially in light of all the physical variables affecting the volume of the sealed bearing space.

If the Examiner is arguing Uchiyama *et al.* inherently discloses injecting lubricating oil based on the to-be-sealed bearing space, then the Examiner is required to provide a basis in fact and/or technical reasoning to support his argument that the inherent characteristics are present in the teachings of the applied reference. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). At present, the Examiner's argument with respect to the cage oil percentages lacks any factual or technical reasoning of how the lubricating oil impregnated in the rolling element cage of Uchiyama *et al.* meets the volume requirements for lubricating oil injected into the to-be-sealed bearing space. Based on the foregoing reasons, Applicants believe that Uchiyama *et al.* do not clearly anticipate all the recitations of claim 1, as required by *Hybritech* and *Richardson*.

Thus, Applicants believe that claim 1 is allowable over Uchiyama *et al.*, and further believe that claims 2, 3, 5, 6 and 8 are allowable as well, at least by virtue of their dependency from claim 1.

Independent claims 9, 22 and 23 each have recitations that are similar to claim 1, namely a bearing with an amount of lubricating oil injected into a to-be-sealed bearing space, wherein the amount of injected lubricating oil is: (1) in a range of 1 to 50% by volume of the bearing space, and (2) excludes any lubricating oil preliminarily impregnated in a rolling element cage. Applicants believe that Uchiyama *et al.* do not clearly anticipate all the recitations of claims 9, 22 and 23 at least for the same reasons set forth above with respect to claim 1. Therefore, Applicants believe that claims 9, 22 and 23 are allowable over Uchiyama *et al.* as well.

For claim 18, Uchiyama *et al.* fail to teach or suggest a bearing comprising a lubricating oil contained in a sealed bearing space, wherein the amount of contained lubricating oil is: (1) in a range of 1 to 50% by volume of the bearing space, and (2) excludes any lubricating oil preliminarily impregnated in a rolling element cage. The language of claim 18 specifies that the amount of lubricating oil contained in the sealed bearing is based upon the volume of the bearing space defined by the sealing members. In contrast, Uchiyama *et al.* disclose that the amount of lubricating oil used in a rolling bearing is the amount of oil impregnated into a rolling element cage. Again, while the Examiner argues that the cage oil percentages of Uchiyama are considered to generate volume percentages that overlap those recited in claim 18, in fact the language of claim 18 specifically *excludes* any lubricating oil impregnated in the rolling element cage from the volume-based amount contained in the sealed bearing. *See, e.g.*, page 9, lines 8-12 of the instant specification. As noted above, the Examiner's inherency argument with respect to the cage oil weights lacks any factual or technical reasoning of how one of ordinary skill in the art would allegedly derive the volume requirements of claim 18 from the oil weight disclosure of Uchiyama *et al.* Based on the foregoing reasons, Applicants believe that Uchiyama *et al.* do not clearly anticipate all the recitations of claim 18, as required by *Hybritech* and *Richardson*, and thus, claim 18 is allowable over Uchiyama *et al.*

Independent claims 19 and 20 each have recitations that are similar to claim 18, namely a bearing comprising a lubricating oil contained in a sealed bearing space, wherein the amount of contained lubricating oil is: (1) in a range of 1 to 50% by volume of the bearing space, and (2) excludes any lubricating oil preliminarily impregnated in a rolling element cage. Applicants

believe that Uchiyama *et al.* do not clearly anticipate all the recitations of claims 19 and 20 for the same reasons set forth above with respect to claim 18. Therefore, Applicants believe that claims 19 and 20 are allowable over Uchiyama *et al.* as well.

2. Claims 10-17, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Uchiyama *et al.* in view of the Examiner's Official Notice of common knowledge in the art. The rejection of claim 13 is now moot due to its cancellation. Applicants traverse the rejection of claims 10-12, 14-17, 24 and 25 at least for the reasons set forth below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In*

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re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

Applicants traverse the Examiner’s reliance of Official Notice of common knowledge in the art. The Examiner has cited Mouri *et al.* for the disclosure of an actuator. To the extent that the Examiner’s Official Notice extends beyond that statement from the August 20, 2003 Final Office Action, Applicants traverse the Official Notice and note that the Examiner has not cited any prior art that discloses a bearing comprising an amount of lubricating oil that in a sealed bearing space, and wherein the amount of lubricating oil in the sealed bearing space is based on the volume of the sealed bearing space.

The combination of Uchiyama *et al.* and common knowledge in the art fails to teach or suggest a bearing with an amount of lubricating oil injected into a to-be-sealed bearing space, wherein the amount of injected lubricating oil is: (1) in a range of 1 to 50% by volume of the bearing space, and (2) excludes any lubricating oil preliminarily impregnated in a rolling element cage. The language of claim 10 specifies that the amount of lubricating oil injected into the bearing is based upon the volume of the bearing space defined by the sealing members. In contrast, the combination of Uchiyama *et al.* and common knowledge in the art discloses that the amount of lubricating oil used in a rolling bearing is the amount of oil impregnated into a rolling element cage. While the Examiner argues that the combination of Uchiyama *et al.* and common knowledge in the art discloses the lubricating oil volume percentages, the language of claim 10 specifically *excludes* any lubricating oil impregnated in the rolling element cage from the volume-based amount of *injected* lubricating oil. In the combination of Uchiyama *et al.* and common knowledge in the art, the lubricating oil is already contained in the rolling element cage, and an amount of injected lubricating oil, based on bearing space volume and excluding any oil impregnated in the rolling element cage, is neither taught nor suggested. Based on the foregoing reasons, Applicants believe that Examiner has not met the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

The Examiner has not provided any clear and particularized findings with respect to motivation to combine Uchiyama *et al.* with common knowledge in the art, as required by *In re Dembiczak* and *In re Zurko*. Since the Examiner has not provided any reasoning whatsoever with respect to motivation to combine, Applicants believe that Examiner has not met the

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motivation prong of a *prima facie* case of obviousness.

Thus, Applicants believe that claim 10 is allowable, and further believe that claims 11, 12 and 14-17 are allowable as well, at least by virtue of their dependency from claim 10.

Independent claims 24 and 25 each have recitations that are similar to claim 10, namely a bearing with an amount of lubricating oil injected into a to-be-sealed bearing space, wherein the amount of injected lubricating oil is: (1) in a range of 1 to 50% by volume of the bearing space, and (2) excludes any lubricating oil preliminarily impregnated in a rolling element cage.

Applicants believe that the combination of Uchiyama *et al.* and common knowledge in the art does not render the recitations of claims 24 and 25 obvious for the same reasons set forth above with respect to claim 10. Therefore, Applicants believe that claims 24 and 25 are allowable over the combination of Uchiyama *et al.* and common knowledge in the art.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373

CUSTOMER NUMBER

Date: December 18, 2003